

ESTTA Tracking number: **ESTTA192388**Filing date: **02/13/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Elenbaas Hardwood, Incorporated		
Entity	Corporation	Citizenship	Michigan
Address	2363 Port Sheldon Ct. Jenison, MI 49428 UNITED STATES		

Attorney information	Michael B. O'Neal Warner Norcorss & Judd LLP 111 Lyon Street, NW, Suite 900 Grand Rapids, MI 49503 UNITED STATES moneal@wnj.com, trademarks@wnj.com Phone:616-752-2413
----------------------	---

**Registration Subject to Cancellation**

Registration No	2594112	Registration date	07/16/2002
Registrant	Phil Elenbaas Millwork, Inc. 300 Wilson, N.W. Grand Rapids, MI 49544 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 019. First Use: 1990/04/01 First Use In Commerce: 1990/04/01 All goods and services in the class are cancelled, namely: WOOD MOLDINGS
Class 040. First Use: 1990/04/01 First Use In Commerce: 1990/04/01 All goods and services in the class are cancelled, namely: MANUFACTURE OF MILL RUN AND ARCHITECTURAL MOLDINGS TO THE ORDER AND SPECIFICATION OF OTHERS; CUSTOM MANUFACTURE OF MILL RUN AND ARCHITECTURAL MOLDINGS

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
---	---

Attachments	Elenbaas Hardwood Petition for Cancellation.pdf ( 18 pages )(648821 bytes )
-------------	---

**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/Michael B. O'Neal
Name	Michael B. O'Neal
Date	02/13/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In The Matter Of Registration No. 2,594,112

Date of Issue: July 16, 2002

Mark: PHILLIP ELENBAAS FINE MILLWORK

Elenbaas Hardwood, Incorporated	)
	)
Petitioner,	)
	)
v.	)
	)
Phil Elenbaas Millwork, Inc.	)
	)
Registrant.	)
_____	)

Cancellation No. \_\_\_\_\_

**PETITION FOR CANCELLATION**

Petitioner Elenbaas Hardwood, Incorporated, a Michigan corporation, having its principal office at 2363 Port Sheldon Ct., Jenison, Michigan 49428, believes that it is and will be damaged by Registration No. 2,594,112 (the “**Registration**”) and hereby petitions to cancel the Registration.

As grounds for the cancellation, Petitioner alleges as follows:

**Introduction**

1. Petitioner is currently engaged in the manufacture and sale of wood moldings, doors, stair systems, plywood and lumber. Petitioner uses the mark ELENBAAS HARDWOOD INC. (“**Petitioner’s Mark**”) in connection with its products and services.

2. Petitioner filed U.S. Trademark Application, Serial No. 77/249041 to register the mark ELENBAAS HARDWOOD INC. on August 7, 2007. On December 10, 2007,

the USPTO refused to register Petitioner's Mark based on alleged likelihood of confusion with Registrant's Mark (defined below).

3. Registrant Phil Elenbaas Millwork, Inc. is the current owner of record of the Registration for the mark PHILLIP ELENBAAS FINE MILLWORK (design) ("**Registrant's Mark**") for "the manufacture of mill run and architectural moldings to the order and specification of others; custom manufacture of mill run and architectural moldings."

4. The Registration was obtained through fraud. Namely, at the time of filing the application that matured into the Registration, Registrant fraudulently declared that it knew of no person or entity that had the right to use a mark that was likely to create confusion with Registrant's Mark. Registrant made such declaration with the full knowledge that Petitioner was using Petitioner's mark and that such use pre-dated Registrant's earliest use of Registrant's Mark.

5. However, and contrary to Registrant's declaration, Registrant believes that Petitioner's Mark will create confusion with Petitioner's Mark.

### **Background**

6. Petitioner was founded in 1949 by Earl Elenbaas. In 1982, Earl's sons, David and Phillip, bought the family business.

7. Petitioner and its predecessor-in-interest have used Petitioner's Mark or variations of Petitioner's Mark since it was founded in 1949. Petitioner has used the ELENBAAS HARDWOOD INC. mark, in its current form, since at least as early as April 1984.

8. From 1982 to 1989, David and Phillip worked together and operated Petitioner's business. In 1989, David bought Phillip's interest in Petitioner.

9. In April 1990, Phillip started his own business less than ten miles from Petitioner's place of business. Phillip's business, Phil Elenbaas Millwork, Inc., is the Registrant.

10. On February 21, 2001, Registrant filed an application to register the mark PHILLIP ELENBAAS FINE MILLWORK (design). At the time of filing its application, Registrant alleged that it has used Registrant's Mark since April 1, 1990.

11. When Registrant filed its application, Phillip Elenbaas, acting on behalf of Registrant, declared that:

to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use said mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

12. The application was published for opposition on April 23, 2002, and Registration No. 2,594,112 was issued on July 16, 2002.

13. Petitioner filed U.S. Trademark Application, Serial No. 77/249041 to register the mark ELENBAAS HARDWOOD INC. on August 7, 2007. In an Office Action dated December 10, 2007, the examining attorney assigned to Petitioner's application refused registration based on an alleged likelihood of confusion with Registrant's mark. A copy of the Office Action is attached as Exhibit A.

14. Upon receipt of the Office Action containing this refusal, Petitioner contacted Registrant to propose that the parties enter into a Mutual Consent and Coexistence Agreement.

15. Registrant refused to enter into such an agreement because it believes that the registration of Petitioner's mark "would create a likelihood of confusion and would have a dilutive effect on [its mark]." See correspondence attached as Exhibit B.

**Cause Exists to Cancel Registration No. 2,594,112**

16. Cause exists to cancel Registration No. 2,594,112 under § 14(3) of the Lanham Act because the Registration was obtained through fraud.

17. Registrant's declaration was fraudulent in light of Phillip Elenbaas's knowledge of Petitioner's right to use Petitioner's Mark at the time it signed the declaration and its admission to Petitioner that it believes the marks will likely create confusion.

18. There have not been any material changes from the time Registrant filed its application until now that would cause the Registrant to change its belief to now believe the marks will create confusion.

19. There is no issue as to priority. Registrant's application date and date of first use of its mark are both subsequent to Petitioner's first use of its mark.

20. Since Petitioner has priority, Registrant would not have been able to register its mark if the USPTO had been aware of Petitioner's mark – i.e. if Registrant had been truthful in its application.

21. Continuation of the Registration for PHILLIP ELENBAAS FINE MILLWORK (design) is damaging to Petitioner because Petitioner is using and seeking to register the mark ELENBAAS HARDWOOD INC. in connection with the manufacture and sale of wood moldings, doors, stair systems, plywood and lumber, and this registration is adversely impacting Petitioner's right to use and register the mark. Specifically, the USPTO refuses to register Petitioner's Mark because of the existence of Registration No. 2594112.

22. If this registration is not cancelled, then Registrant will continue to have at least a *prima facie* exclusive right to use the PHILLIP ELENBAAS FINE MILLWORK (design)

mark for wood moldings, which such right was obtain fraudulently. As a result, the Registration is a source of damage and injury to Petitioner.

23. Based on the foregoing, the Registration is causing, and will continue to cause, injury and damage to Petitioner.

WHEREFORE, Petitioner requests that Registration No. 2,594,112 for PHILLIP ELENBAAS FINE MILLWORK (design) be canceled and that this cancellation be sustained.

Dated: February 13, 2008.

Respectfully submitted,  
ELENBAAS HARDWOOD,  
INCORPORATED

By: Warner Norcross & Judd LLP  
Attorneys for Petitioner

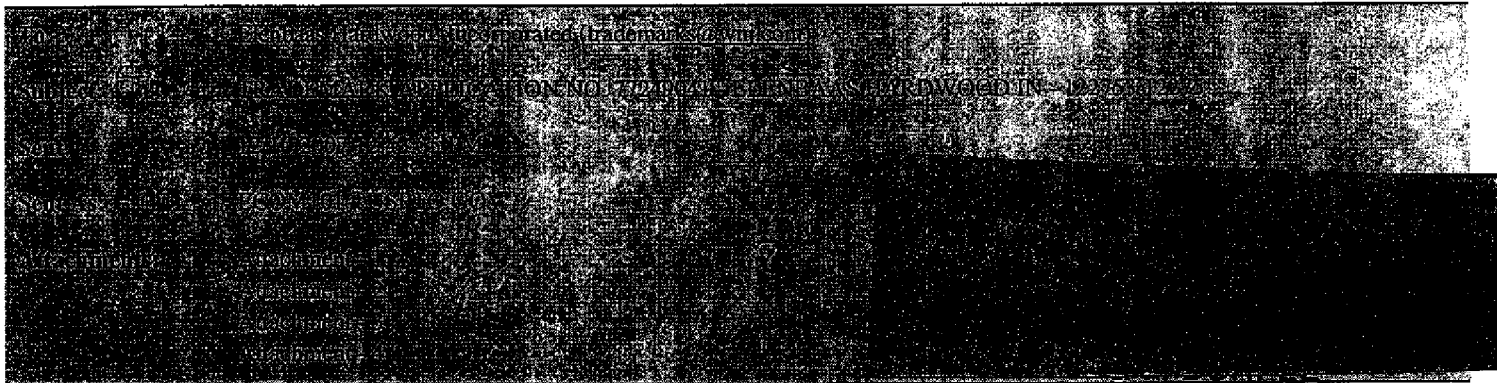
/s/ Michael B. O'Neal  
Charles E. Burpee  
Jeffrey A. Nelson  
Michael B. O'Neal  
900 Fifth Third Center  
111 Lyon Street, N.W.  
Grand Rapids, Michigan 49503-2487  
(616) 752-2000  
(616) 222-2000 (fax)

#### **CERTIFICATE OF SERVICE**

I hereby certify that a true copy of this Petition for Cancellation was sent by United States first class mail to Patrick J. Sullivan, Miller Johnson, Calder Plaza Building, 250 Monroe Avenue, NW, P.O. Box 306, Grand Rapids, MI 49501-0306.

/s/ Michael B. O'Neal  
Michael B. O'Neal

# EXHIBIT A



## UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/249041

MARK: ELENBAAS HARDWOOD IN

**\*77249041\***

**CORRESPONDENT ADDRESS:**

CHARLES E. BURPEE  
WARNER NORCROSS & JUDD LLP  
111 LYON STREET, NW  
900 FIFTH THIRD CENTER  
GRAND RAPIDS, MI 49503-2487

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Elenbaas Hardwood,  
Incorporated

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

122753.12275

**CORRESPONDENT E-MAIL ADDRESS:**

trademarks@wnj.com

## OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION  
WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE: 12/10/2007**

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:



#### **SECTION (d) - Likelihood of Confusion Refusal**

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2594112. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. In *re* E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. In *re* August Storck KG, 218 USPQ 823 (TTAB 1983); In *re* International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The examining attorney has determined that contemporaneous use of the marks ELENBAAS HARDWOOD INC. (used in connection with “Wholesale and retail store services in the field of wood moldings, doors, stair systems, plywood, and lumber”) and PHILLIP ELENBAAS FINE MILLWORK, and design, (used on “WOOD MOLDINGS” and in connection with “MANUFACTURE OF MILL RUN AND ARCHITECTURAL MOLDINGS TO THE ORDER AND SPECIFICATION OF OTHERS; CUSTOM MANUFACTURE OF MILL RUN AND ARCHITECTURAL MOLDINGS”) would be likely to cause confusion for the following reasons.

The Court in *In re* E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods services, and similarity of trade channels of the goods and services.

#### **A. The Marks**

The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. In *re* National Data Corp., 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In *re* J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1988).

The addition of the design element to the registrant’s mark does not obviate the similarity between the marks. *Coca#Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975). When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. In *re* Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976).

Disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. In *re* Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); In *re* National Data Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and In *re* Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); In *re* El Torito Rests. Inc., 9 USPQ2d 2002 (TTAB 1988); In *re* Equitable Bancorporation, 229 USPQ 709 (TTAB 1986).

In this instance, both marks reference the same surname – ELENBAAS. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See e.g., *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii).

Furthermore, when the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

#### B. The Goods and Services

The goods and services of both parties are related as they involve wood moldings and goods related thereto. Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

Furthermore, the applicant is advised that the goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Moreover, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB

1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

And finally, the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner#Lambert Co.*, 203 USPQ 191 (TTAB 1979).

### C. Conclusion

For the foregoing reasons, the applicant's ELENBAAS HARDWOOD INC. is refused registration under Section 2(d) of the Trademark Act.

Applicant should note the following additional ground for refusal.

### SECTION 2(e)(4) REFUSAL – Primarily Merely A Surname

The examining attorney refuses registration on the Principal Register because the mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4); TMEP section 1211. The examining attorney must consider the primary significance of the mark to the purchasing public to determine whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975). Attached please find the first 100 of 300 listings of the surname “Elenbaas” from the *LEXIS/Nexis Research database*, thereby establishing the surname significance of the term. The frequency with which “Elenbaas” appears as a surname substantiates its primary significance as that of a primarily merely surname.

The addition of the highly descriptive terminology HARDWOOD INC. to the surname ELENBAAS fails to overcome the primarily merely significance of the proposed mark. Combining a surname with the generic name for the goods or services does not overcome a mark's surname significance. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS held primarily merely a surname for “pharmaceutical products”); *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname when used in connection with “restaurant services”); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES held primarily merely a surname for hotel and motel services).

Although the examining attorney has refused registration, the applicant may respond to the refusals to register by submitting evidence and arguments in support of registration.

### Section 2(f) – Section 2(e)(4) Refusal Only

A mark deemed primarily merely a surname may be registered on the Principal Register under Section 2(f) (“acquired distinctiveness”) by satisfying one of the following:

- (1) Submitting a claim of ownership of one or more prior registrations on the Principal Register for a mark that is the same as the mark in the application and for the same or related goods and/or services. 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*
- (2) Submitting the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The mark has become distinctive of applicant's goods and/or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years preceding the date of this statement.”** 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*
- (3) Submitting actual evidence of acquired distinctiveness. 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.* This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising,

consumer or dealer statements of recognition of the mark as a source identifier, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. *See In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp. of Am.*, 201 USPQ 957 (TTAB 1979).

15 U.S.C. §1052(f); TMEP §§1211 and 1212.02(a).

### **INFORMALITIES**

If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement(s).

#### **Disclaimer**

Applicant must disclaim the descriptive wording “HARDWOOD INC.” apart from the mark as shown because it merely describes a feature of the goods offered for sale by the applicant and the nature of its entity. Terms such as “Corporation,” “Inc.” and “Ltd.” must be disclaimed because they merely specify applicant’s entity type and do not function as a trademark or service mark to indicate source. *See In re Patent & Trademark Services, Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998); *In re Industrial Relations Counselors, Inc.*, 224 USPQ 309, 310 n.2 (TTAB 1984); *In re E. I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984); TMEP §1213.03(d). Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “HARDWOOD INC.” apart from the mark as shown.

*See In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Katherine Stoides/

Trademark Examining Attorney

Law Office 101

(571) 272-9230

**RESPOND TO THIS ACTION:** If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at

<http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

**Print: Nov 19, 2007**

**76213558**

**DESIGN MARK**

**Serial Number**

76213558

**Status**

REGISTERED

**Word Mark**

FINE PHILLIP ELENBAAS MILLWORK

**Standard Character Mark**

No

**Registration Number**

2594112

**Date Registered**

2002/07/16

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Phil Elenbaas Millwork, Inc. CORPORATION MICHIGAN 300 Wilson, N.W.  
Grand Rapids MICHIGAN 49544

**Goods/Services**

Class Status -- ACTIVE. IC 019. US 001 012 033 050. G & S: WOOD  
MOLDINGS. First Use: 1990/04/01. First Use In Commerce: 1990/04/01.

**Goods/Services**

Class Status -- ACTIVE. IC 040. US 100 103 106. G & S: MANUFACTURE  
OF MILL RUN AND ARCHITECTURAL MOLDINGS TO THE ORDER AND SPECIFICATION  
OF OTHERS; CUSTOM MANUFACTURE OF MILL RUN AND ARCHITECTURAL MOLDINGS.  
First Use: 1990/04/01. First Use In Commerce: 1990/04/01.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FINE MILLWORK" APART  
FROM THE MARK AS SHOWN.

**Name/Portrait Statement**

"PHILLIP ELENBAAS" identifies a living individual whose consent is of  
record.

**Print: Nov 19, 2007**

**76213558**

**Filing Date**  
2001/02/21

**Examining Attorney**  
SHIELDS, JULIA S.

**Attorney of Record**  
Barry C. Kane





14085 K

CLIENT: KATHERINE STOIDES  
LIBRARY: FINDER  
FILE: 5-2000

SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:  
NAME (1) JAMES CLEGG (1)

OF DOCUMENTS FOUND WITH YOUR REQUEST THROUGH

1. **CONCLUSIONS**

SELECTED DOCUMENT NUMBERS:

Y FORMAT: 500

**MALE, 111 (FEMALE**

LAAS, PETER B. OMA  
LAAS, T. L. OMA

[illegible]

NOV LINES	POL 06499	1000K	*
A P.M. STARTED	Late P.H. HENDED	11/29/77	y
NAME	SEX	DOB	
E	M	D 5	"
E	M	D 5	"
JAC	M	D 5	"
T	M	D 5	"
X	F	D 5	"

1: HCA5000, DATE  
TRULHMAN; LAW LIBRARY  
600 MULBURY ST  
ALEXANDRIA, VIRGINIA 22314-5700

**To:** Elenbaas Hardwood, Incorporated ([trademarks@wnj.com](mailto:trademarks@wnj.com))  
**Subject:** TRADEMARK APPLICATION NO. 77249041 - ELENBAAS HARDWOOD IN - 122753.12275  
**Sent:** 12/10/2007 12:43:42 PM  
**Sent As:** ECOM101@USPTO.GOV  
**Attachments:**

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 12/10/2007 FOR**  
**APPLICATION SERIAL NO. 77249041**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link  
[http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77249041&doc\\_type=OOA&mail\\_date=20071210](http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77249041&doc_type=OOA&mail_date=20071210)  
(or copy and paste this URL into the address field of your browser), or visit  
<http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 12/10/2007.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

1. The USPTO will NOT send a separate e-mail with the Office action attached.
2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.



**EXHIBIT B**

Calder Plaza Building  
250 Monroe Avenue NW  
Suite 800  
P.O. Box 306  
Grand Rapids, MI 49501-0306



**PATRICK J. SULLIVAN**  
Attorney at Law

616.831.1765  
616.988.1765 fax  
SullivanP@millerjohnson.com

January 21, 2008

Mr. Jeffrey A. Nelson  
Warner, Norcross & Judd, LLP  
Fifth Third Center  
111 Lyon Street, N.W., Suite 900  
Grand Rapids, MI 49503

Re: Phil Elenbaas Millwork, Inc.

Dear Jeff:

Miller Johnson represents Phil Elenbaas Millwork, Inc. I am in receipt of your letter dated January 10, 2008 requesting that Phil Elenbaas Millwork, Inc. execute a Mutual Consent and Coexistence Agreement in order to assist your client, Elenbaas Hardwood, Inc., in its attempt to register the ELENBAAS HARDWOOD, INC. trademark with the United States Patent and Trademark Office.

My client respectfully declines your request to execute your proposed Mutual Consent and Coexistence Agreement. Phil Elenbaas Millwork, Inc. has expended substantial resources in developing its trademark. My client is concerned that registration of your client's proposed mark would create a likelihood of confusion and would have a dilutive effect on its PHILLIP ELENBAAS FINE MILWORK trademark. This concern was apparently shared by the USPTO in its refusal to register your client's mark.

Your letter references an alternative in which your client may petition to cancel the registration of the PHILLIP ELENBAAS FINE MILWORK trademark. Registration of the PHILLIP ELENBAAS FINE MILWORK mark has been effective since July 16, 2002. Because this registration has been in place for more than five years, any petition to cancel my client's mark would require a petition for cancellation compliant with § 14(3) of the Lanham Act. No factual basis exists for filing a petition for cancellation of my client's mark under § 14(3) of the Lanham Act.

MILLER JOHNSON

Mr. Jeffrey A. Nelson  
January 21, 2008  
Page 2


---

If you have any additional questions regarding my client's position, please feel free to contact me.

Very truly yours,

MILLER JOHNSON

By

  
Patrick J. Sullivan

PJS:kag

cc: Laurie Elenbaas  
Alan C. Schwartz